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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,615	03/29/2001	Katsuaki Matsuo	19036/37155	4565

4743 7590 09/05/2003

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO, IL 60606

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 09/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/806,615

Applicant(s)

MATSUO ET AL.

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): see attachment.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 25-38.Claim(s) objected to: 16-18 and 22-24.Claim(s) rejected: 10, 12-15, and 19-21.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' amendment and 1.132 declaration filed 8/8/03 have been fully considered.

The amendment overcomes the claim objection and 35 USC 112 rejections of record. The amendment places claims 25-38 in condition for allowance. Claims 16-18 and 22-24 are now objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 10, 12-15 and 19-21, which are drawn to resin composition, remain rejected by the references of record as set forth in paragraphs 6, 7, 11, and 12 of the office action mailed 5/7/03.

With respect to claims 10, 12-15 and 19-21, in the amendment and declaration filed 8/8/03, applicants argue that there is no motivation to combine JP 11123869 with JP 09296035 given that there is no need for the resin composition of JP 11123869 to have adhesiveness to substrate layer because of the presence of glue line in JP 11123869 which adheres the resin composition to the substrate layer.

It is noted that JP 11123869 discloses resin composition for ink jet recording comprising hydrophilic polymer and cationic polymer obtained from 65-98.9% ethylene, 0.1-15% acrylate, and 1-35% acrylamide identical to presently claimed formula IV. However, there is no disclosure of water-absorbing polymer as presently claimed. This is why JP 11123869 is combined with JP 09296035, which discloses the use of water-absorbing polymer identical to that presently claimed.

While it is agreed that there is no need for the resin composition of JP 11123869 to have adhesiveness due to the presence of glue line, it is noted that the motivation for using the polymer of JP 09296035 is not adhesiveness but rather due to its outstanding water absorbitivity.

Given that JP 11123869 is drawn to ink jet recording sheet comprising substrate layer and water color ink acceptance layer, i.e. ink receiving layer, which comprises the resin composition as described above and an ink jet recording method wherein aqueous ink is applied to ink receiving layer, it is clear that using polymer which has excellent water-absorbitivity is a especially relevant to JP 11123869. Thus, it is the examiner's position that there is good motivation to combine JP 11123869 with JP 09296035. While the motivation for using the water-absorbing polymer disclosed by JP 09296035 may not be the same motivation as in the present invention, it is noted that "obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation.", *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

Applicants argue that neither JP 1123869 or JP 09296035 disclose resin composition that can achieve sufficient adhesiveness by direct application to substrate without glue line which is in direct contrast to the present claims which discloses resin composition that can be applied directly to substrate layer with glue line.

However, it is noted that claims 10, 12-15, and 19-21 are drawn to resin composition, not method of using the resin composition. Claims 10, 12-15, and 19-21 are drawn to resin composition comprising water-absorbing polymer and cationic polymer which is met by the combination of JP 11123869 and JP 09296035. While neither JP 11123869 nor JP 09296035 may disclose resin compositions with sufficient adhesiveness for direct application to substrate, the references are not applied individually against the present claims but rather the references are used in combination. Given that the combination of JP 11123869 and JP 09296035 discloses resin composition identical to that presently claimed, it is clear that such composition would

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intrinsically possess the same adhesiveness to substrate as the resin composition presently claimed.

Applicants argue that the present specification provides comparative data wherein the resin composition as presently claimed is compared to resin composition outside the scope of the present claims, i.e. comprising water-absorbing polymer and different types of cationic polymers. While the data shows that the presently claimed resin composition is superior in terms of ink absorption and ink blurring, it is the examiner's position that this data does not establish unexpected or surprising results over the cited prior art given that JP 11123869 already discloses the criticality of using cationic polymer as presently claimed.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
9/2/03